

REMARKS

In the Final Office Action, the Examiner rejected claims 1-3 and 17 under 35 U.S.C. §103(a) as being unpatentable over Sethuraman et al. (U.S. Patent No. 6,526,097.) Applicants submit that the rejection is improper because a *prima facie* case of obviousness has not been established.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Furthermore, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." See M.P.E.P. § 2143.01 (8th Ed., Aug. 2001), quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. See M.P.E.P. § 2143 (8th Ed. 2001), pp. 2100-122 to 127.

Sethuraman et al. fails to teach or suggest each and every element of claims 1-3 and 17. Claim 1 recites a combination including, *inter alia*, "a mode selector to select a first shoot mode for obtaining a high quality motion video file or a second shoot mode for obtaining a compression-encoded motion video file suitable for real time transmission via the network" (emphasis added) and "a control section configured to execute the second shoot mode to control said video encoding section to match a bit rate of an encoded video signal obtained by said video encoding section with a communication speed of the network used to transmit the video file when the second

shoot mode is selected.” Sethuraman et al. fails to disclose at least these claim elements.

The Examiner alleges that the claimed mode selector is taught by Sethuraman et al. at col. 3, lines 37-44 and FIG. 3. (See Office Action at page 5.) The cited portion of Sethuraman et al., however, specifically teaches that:

[i]n system 100, video controller 106 controls the operations of all of the other modules in system 100. In particular, video controller 106 controls the operations of frame acquisition module 104, buffer and multiplex module 110, and audio/data module 112. Video controller 106 also does all the multiplexing and handshaking with the remote clients. As a result, encoder 108 can be implemented independent of video controller 106, with an agreed-upon interface 116 between the controller and the encoder.

(Emphasis added) Furthermore, in FIG. 3, Sethuraman et al. teaches the processing performed by the function rcInItGOP. (Col. 6, lines 6-7.) The Examiner further alleges that the YES path in step 302 of FIG. 3 constitutes the claimed first shoot mode and the NO selection constitutes the claimed second shoot mode. (OA at 3.) However, step 302 of FIG. 3 teaches the processing of I frames and processing the I frames differently depending on whether the I frame is the first frame in a video sequence or whether it is not the first frame in the video sequence. (Col. 6, lines 6-42.) These teachings cannot constitute a teaching of “a mode selector to select a first shoot mode for obtaining a high quality motion video file or a second shoot mode for obtaining a compression-encoded motion video file suitable for real time transmission via the network” and “a control section configured to execute the second shoot mode to control said video encoding section to match a bit rate of an encoded video signal obtained by said video encoding section with a communication speed of the network used to transmit the video file when the second shoot mode is selected,” as recited in claim 1. That is,

determination of whether an I frame is the first frame or not cannot constitute a teaching or suggestion of the claimed "mode selector." Therefore, no *prima facie* case has been established since Sethuraman et al. fails to teach or suggest each and every element of claim 1.

Independent claim 17, although of different scope, recites elements similar to that discussed above with regard to claim 1. Applicants, therefore, submit that claim 17 is also allowable over Sethuraman et -al. Claims 2 and 3 depend from claim 1 and are thus also allowable over Sethuraman et al. for at least the same reasons as claim 1.

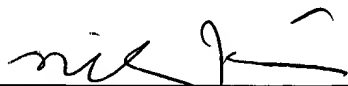
In view of the foregoing remarks, Applicants submit that the outstanding rejections are improper and should be withdrawn. Applicants therefore request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 22, 2005

By: 
Milan S. Kapadia
Reg. No. 55,982